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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/815,193	04/01/2004	Tetsuji Shono	125120	7934

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EXAMINER	
VILLECCO, JOHN M	
ART UNIT	PAPER NUMBER
2612	

DATE MAILED: 12/28/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/815,193	SHONO, TETSUJI	
	Examiner	Art Unit	
	John M. Villecco	2612	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *01 April 2004*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-31* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-31* is/are rejected.

7)☒ Claim(s) *15,16,24 and 25* is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *01 April 2004* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☒ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☒ Certified copies of the priority documents have been received in Application No. 09/089,404.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date *11/15/04; 7/7/04*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Reissue Applications

1. The original patent, or a statement as to loss or inaccessibility of the original patent, must be received before this reissue application can be allowed. See 37 CFR 1.178.

Double Patenting

2. A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

3. Claims 1-13 are provisionally rejected under 35 U.S.C. 101 as claiming the same invention as that of claims 1-13 of copending Application No. 10/815,194. This is a provisional double patenting rejection since the conflicting claims have not in fact been patented.

4. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970);and, *In re Thorington,* 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

5. Claims 14-31 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 14-31 of copending Application No. 10/815,194 (hereinafter referred to as the '194 application). Although the conflicting claims are not identical, they are not patentably distinct from each other because the method claims of the present application could obviously be carried out using the apparatus of the '194 application. More specifically, a double-patenting rejection is proper between a set of method claims and a set of apparatus claims when the apparatus of the reference claims could obviously be used to carry out the method of the present application. In this instance, the

apparatus claims presented in the '194 application could obviously be used to carry out the method claims of the present application.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. **Claims 14, 17, 19, 22, 23, 26, 28, and 31 are rejected under 35 U.S.C. 102(b) as being anticipated by Wakabayashi (U.S. Patent No. 4,597,657).**

8. Regarding ***claim 14***, Wakabayashi discloses a compact camera capable of changing an optical property of the lens system. More specifically, Wakabayashi discloses a camera (10) that includes a lens barrel (14) which is retractable into and out of the camera body (10). The lens barrel is moved along an optical axis between a plurality of photographic positions and one position in which no photograph can be taken. See Figures 8-10. The camera includes a lens (114), an auxiliary lens (174), and a dust cover (112). When the camera is in the telephoto position (T), the lens (114) and auxiliary lens (174) are placed in the optical axis. When the camera is in the OFF position, the auxiliary lens (174) is placed outside of the optical axis, on a plane perpendicular to the optical axis, and dust cover (112) is placed on the optical axis.

Because the dust cover (112) is placed over the optical axis, the lens barrel is place in a position in which no photograph can be taken.

9. As for ***claim 17***, Wakabayashi discloses a lens (114) and film (68) which serves as the image pickup device.

10. With regard to ***claim 19***, Wakabayashi discloses the use of a plurality of lenses (114 and 174) and film (68) which serves as the image pickup device.

11. Regarding ***claim 22***, Wakabayashi discloses that the lens system is moveable between a telephoto position and a wide position. This constitutes a zoom range.

12. ***Claim 23*** is considered substantively equivalent to claim 14. Please see the discussion of claim 14, previously presented.

13. ***Claim 26*** is considered substantively equivalent to claim 17. Please see the discussion of claim 17, previously presented.

14. ***Claim 28*** is considered substantively equivalent to claim 19. Please see the discussion of claim 19, previously presented.

15. ***Claim 31*** is considered substantively equivalent to claim 22. Please see the discussion of claim 22 presented above.

Claim Rejections - 35 USC § 103

16. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

17. **Claims 18, 20, 27, and 29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wakabayashi (U.S. Patent No. 4,597,657).**

18. Regarding ***claim 18***, as mentioned above in the discussion of claim 17, Wakabayashi discloses all of the limitations of the parent claim. However, Wakabayashi fails to specifically disclose that the image pickup device is a charge-coupled device. Official Notice is taken as to the fact that it is well known in the art to use charge-coupled devices (CCD) to collect images. CCD's provide numerous advantages over film, such as quick development of images and easy storage and transfer of images. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to use a CCD to collect the images of Wakabayashi instead of film for the advantages listed above.

19. ***Claim 20*** is considered substantively equivalent to claim 18. Please see the discussion of claim 18 presented above.

20. ***Claim 27*** is considered substantively equivalent to claim 18. Please see the discussion of claim 18 presented above.

21. ***Claim 29*** is considered substantively equivalent to claim 18. Please see the discussion of claim 18 presented above.

22. **Claims 21 and 30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wakabayashi (U.S. Patent No. 4,597,657) in view of Matsumoto et al. (U.S. Patent No. 4,771,303).**

23. Regarding ***claim 21***, as mentioned previously in the discussion of claim 14, Wakabayashi discloses all of the limitations of the parent claim. However, Wakabayashi fails to explicitly

disclose moving the finder in association with the movement of the barrel. Matsumoto, on the other hand, discloses that it is well known in the art to move the finder in association with the amount of movement of a lens system. As discussed in col. 4, lines 48-60, when the photographic lens system is set for the long focal length lens G1 is moved rearward. By moving the finder system of a camera to a position corresponding to the field angle of the photographic lens system the user is able to see the exact view that the camera is about to capture. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to move the finder in association with the lens barrel so that the user is able to see the exact image that is about to be captured.

24. ***Claim 30*** is considered substantively equivalent to claim 21. Please see the discussion of claim 21 presented above.

Allowable Subject Matter

25. Claims 15, 16, 24, and 25 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims, as well as overcoming the obviousness-type double patenting rejection previously presented.

26. The following is a statement of reasons for the indication of allowable subject matter:

Regarding ***claims 15 and 24***, the primary reason for indication of allowable subject matter is that the prior art fails to teach or reasonably suggest that the image pickup device is moved out of the optical axis.

Any response to this action should be mailed to:

Commissioner of Patents and Trademarks
Washington, D.C. 20231

or faxed to:

(703) 872-9306 (For either formal or informal communications intended for entry. For informal or draft communications, please label **"PROPOSED"** or **"DRAFT"**)

Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive, Arlington VA, Sixth Floor (Receptionist).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to John M. Villecco whose telephone number is (703) 305-1460. The examiner can normally be reached on Monday-Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wendy Garber can be reached on (703) 305-4929. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

John M. Villecco
December 21, 2004

WENDY R. GARBER
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